

Remarks

The present Election of Species is made **with traverse** because the Examiner's requirement for an Election from the newly submitted dependent claims 27-35 is improper.

The Examiner's Requirement for an Election of Species from Detail 4.b. is Improper and Should be Withdrawn or Modified

Initially, it is noted that the Examiner has required Election of a Species that has not been claimed. In Detail 4.b. at Page 2 of the Office Action dated October 1, 2007 the Examiner requires Election of a Species from the following:

4.b. wherein the multimer is soluble OR bound to a streptavidin-coupled bead; AND

The use of the term 'soluble' is not present in the pending claims. By requiring an Election of a non-claimed Species, the Examiner is improperly reading limitations into the pending claims. According to the MPEP § 2100:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's en banc decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." In re *Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or

antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

It is plainly not reasonable to force the term "soluble" into these claims through the Examiner's Election of Species Requirement. Under the Examiner's Election of Species, the Examiner has divided this particular species election into a universe of two possibilities: "soluble OR bound to a strepavidin-coupled bead." *See* Office Action at page 2. Applicants assume that the Examiner bases this species election on the presence of dependent claim 29, which recites in relevant part "bound to a strepavidin-coupled bead." As previously mentioned, no claim in the instant application recites "soluble." Thus, the Examiner presumably assumes that if the claimed multimeric protein is not "bound to a strepavidin-coupled bead," then it is soluble. But the Examiner has no basis with the present claims to make that assumption or force that construction on the Applicants. Therefore, Applicants request that the Examiner specifically reconsider and withdraw species election Detail 4.b.

In order to advance prosecution, Applicants are willing to elect as a species for Detail 4.b. language akin to what the Examiner has presented for Detail 4.d. Specifically, the Applicants would ask that the Examiner recast the species election for Detail 4.b. to be "bound to a strepavidin-coupled bead OR not bound to a strepavidin-coupled bead." Under this species election, Applicants would elect, with traverse, the species of "not bound to a strepavidin-coupled bead."

If the Examiner must maintain species restriction Detail 4.b. as presently worded, Applicants will elect with traverse "soluble." Applicants specifically reserve the right to petition from this species election as being improper for the reasons previously explained.

The Examiner's Restriction of Species Detail 4.a. to Detail 4.d. is Improper and Should be Withdrawn

According to the MPEP § 803.02:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where ... (1) share a common utility, and (2) share a substantial structural feature essential to that utility.

The presently claimed invention is drawn to a multimeric protein that may be employed to isolate and purify a population of T lymphocytes. As such, the presently claimed invention encompasses a single invention related in utility and structure. The dependent claims function to limit the claimed invention but are *not* distinct inventions. According to the MPEP § 806:

The general principles relating to distinctness or independence may be summarized as follows:

- (A) Where inventions are independent (i.e., no disclosed relation between), restriction to one thereof is ordinarily proper;
- (B) Where inventions are related as disclosed but are distinct as claimed, restriction may be proper;
- (C) Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper;
- (D) A reasonable number of species may be claimed when there is an allowable claim generic thereto. 37 CFR 1.141, MPEP § 806.04.

The presently claimed invention discloses a relationship between the independent and dependent claims throughout the specification. As such, a person of skill in the art would

understand that the pending claims are directed to a single invention and do *not* claim multiple distinct inventions.

However, *in arguendo*, even if there are multiple inventions claimed in the subject application as the Examiner alleges, the present Election of Species only requires withdrawal of five dependent claims (claims 27 and 32-35). The search and examination of these five dependent claims would not place a serious burden upon the Examiner. Applicants submit that a search of the recited groups would sufficiently overlap with a search of the other groups due to the close relationship among the subject matter shared by the claims.

Request for Rejoinder

The Examiner has required an election of species. In accordance with the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F3d 1565, 37 USPQ2d 1663 (Fed. Cir. 1996), and the notice published in the Official Gazette on March 26, 1996, setting forth guidelines for the treatment of restricted product and process claims (*see* 1184 O.G. 86), Applicants respectfully request that if the election of species is made final and if the claims of the elected species (claims 14, 16, 20 and 28-31) are found allowable, then the remaining claims (claims 27 and 32-25) be rejoined and examined for patentability. *See also* M.P.E.P. § 821.04.

Conclusion

In view of the foregoing comments, Applicants respectfully request that the outstanding Restriction Requirement be reconsidered and withdrawn.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 19-0036.

Consideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,

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